



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nicholas RUSSELL, et al.

Serial No.: 10/522,809

Group Art Unit: To Be Assigned

Filed: January 31, 2005

Examiner: To Be Assigned

For: ANIMATED MESSAGING

RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)

July 5, 2006

MAIL STOP PCT

Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Petition dated May 5, 2006, applicants respectfully request reconsideration and provides additional information including the further Declaration of Nicholas Russell.

The original petition included a signed declaration of Nicholas Russell. Mr. Russell now provides a further declaration setting for more detailed facts and circumstances within his first hand knowledge and stating his current beliefs.

The Decision of May 5, 2006 indicated that further details should be provided setting forth facts and circumstances known first hand and relating to the presentation of documents to co-inventor Anton Felich. To that end, the further declaration of Anton Felich is provided.

The declaration includes an Appendix A which contains various emails exchanged between co-inventor Nick Russell (who has signed) and co-inventor Anton Felich who has refused to sign the US patent application. The emails make it clear that the application was presented to Anton Felich and that, based on professional advice received, he refused to sign the application.

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JUL 10 2006
Legal Staff
International Division

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A chronology of events is set forth in Mr. Russell's declaration.

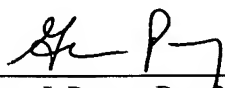
If any fees are due in connection with the filing of this Renewed petition, such as fees under 37 C.F.R. §§1.16 or 1.17, please charge the fees to Deposit Account 02-4300; Order No. 034164.002.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

Date: July 5, 2006

By:



Glenn J. Perry, Reg. 28,458
1850 M Street, N.W., Suite 800
Washington, DC 20036
Telephone: 202/263-4300
Facsimile: 202/263-4311

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Serial No.: 10/522,809

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DECLARATION OF NICHOLAS RUSSELL

MAIL STOP PETITIONS

Commissioner for Patents

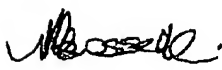
P.O. Box 1450

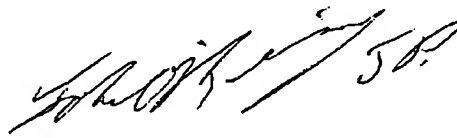
Alexandria, VA 22313-1450

Sir:

I, Nicholas Russell, declare as follows:

1. I have first hand knowledge of the matters set forth herein.
2. I believe that I am a co-inventor of inventions described and claimed in this application. Based on my understanding of the patent law of the United States of America, I believe that Nicholas Russell, Anton Felich and James Jenkins are co-inventors because they each contributed to at least one claim of the application as originally filed in the United States Patent and Trademark Office.
3. I am presently employed by InChain Pty Ltd (assignee of this application). My address at InChain is 1270 Ferntree Gully Road SCORESBY VIC 3179.
4. At the time we made the inventions described in this application, I, Nicholas Russell, and Anton Felich were employed by E-Clips Intelligent Agent Technologies Pty Ltd, whose assets were subsequently purchased by InChain Pty Ltd by way of a sale agreement.


N. RUSSELL



5. I have read the Notification Of Missing Requirements under 35 U.S.C. 371 in The United States Designated/Elected Office (DO/EO/US).

6. I understand that the U.S. Patent and Trademark Office requires the signature of each inventor on the Declaration/Power Of Attorney and Assignment forms.

7. My co-inventor Anton Felich has been presented with a copy of the US patent application as intended to be filed, along with a declaration of the co-inventors and an Assignment of the application.

8. Anton Felich refused to sign the Declaration and Assignment.

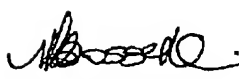
9. Anton Felich is no longer employed by either E-Clips Intelligent Agent Technologies Pty Ltd or InChain Pty Ltd.

10. Declaration and Assignment forms for this application were forward to Anton Felich for his signature in February 2005. However, after at least three telephone calls and a plurality of email reminders some of which are dated March 9, 2005, April 6, 2005 and May 24, 2005 Anton Felich advised that he refuses to sign the Declaration and Assignment on the advice of counsel.

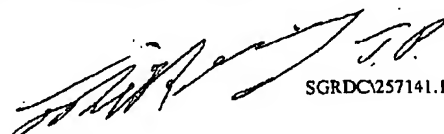
11. I Nicholas Russell, am the only co-inventor still associated with InChain Pty Ltd and have signed the Declaration and Assignment on behalf of Anton Felich.

12. Anton Felich was an employee of E-Clips Intelligent Agent Technologies Pty Ltd beginning in the year 2000.

13. At the time of joining e-clips Anton Felich signed an employment agreement which


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included an IP section that assigned IP to e-clips and further required Anton Felich to sign any documents required to develop and protect the intellectual property of e-clips, even in the event that Mr. Felich would leave the employ of e-clips.

14. I first conceived of the "IMP" software (now the subject of the pending US patent application) in late 2000.

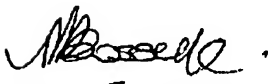
15. I, with the assistance of James Jenkins and Anton Felich, began research and development related to the IMP software in 2001.

16. During the period of research and development, Anton Felich and I began to document the preparatory information necessary for applying for obtaining patent protection. Anton Felich provided the diagrammatic information and I provided text. We developed iterations of patent documentation and provided documents to our patent attorney at the time (Pipers Patent and Trademark Attorneys, Melbourne).

17. We worked with our Patent Attorney to refine our documentation and at each stage, the documentation was reviewed by myself and Anton Felich. An application was submitted to the Australian Patent Office upon final approval of the application by myself and Anton Felich.

18. Shortly after this, we worked with the help of the law firm Thielen Reid to develop a US Patent Application. Once again, I and Anton Felich collaborated and reviewed the resulting documentation prior to submission by Thielen Reid.

19. During 2002, our IMP software product was online and being used by members of the public.


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20. In May 2003, I formed a new company called Inchain. Anton Felich resigned from his employment at e-Clips and became employed by Inchain. He remained so employed until approximately July, 2003 when he resigned to take up employment elsewhere.

21. Since the resignation of Anton Felich, I and other persons affiliated with Inchain have had only limited contact with him. His cell phone number has changed and to my understanding he no longer lives at the residential address that we have on record. As time has moved on since his resignation, he has become less willing to engage with us in anyway.

22. I have had two email address for Anton which is what I used to contact him last time. Those email addresses are: anton.felich@spectral.com.au and anton@clearweb.com.au. My understanding is that Anton Felich is currently employed by a company called "Spectral Lines".

23. I have emailed to all known email addresses the patent application now filed in the United States and follow up requests for signature.

24. Appendix A contains various emails exchanged between co-inventor Nick Russell (who has signed) and co-inventor Anton Felich who has refused to sign the US patent application. The emails make it clear that the application was presented to Anton Felich and that, based on professional advice received, he refused to sign the application.

25. On 27th June 2006 I surface mailed a copy of the US patent application by express post (with a receipt) in care of his parents' last known residential address (which is 6 Grange Rd, Kalorama, VIC 3766, Australia). To date I have received no response.

26. Shortly after this on 27 July 2006 the application was emailed to the two email addresses I have for Anton, namely anton.felich@spectral.com.au and anton@clearweb.com.au. The


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specification was emailed as part of a further effort to get in contact with Anton and to detail the present difficulties with the US counterpart application. To date I have received no response and have been informed that Anton may be on an extended holiday of eight weeks until about August 1st, 2006.

26. The following is the chronology of emails that explain part of the effort to obtain the signature of the "missing" inventor.

March 9, 2005 email from Nick Russell (co-inventor) to Anton Felich (inventor who refuses to sign), indicating that Anton Felich needs to sign "paperwork on the patent". This refers to formal papers for filing the US application.

March 15, 2005 email from Anton Felich (inventor who refuses to sign) to Nick Russell (co-inventor)

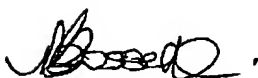
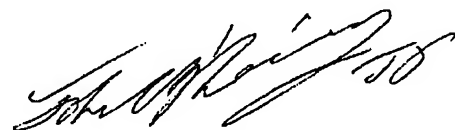
April 6, 2005 email from Nick Russell to Anton Felich following up on the signing of formal papers for US patent application.

April 14, 2005 email from Anton Felich to Nick Russell indicating that he sought advice of a lawyer with respect to patent paperwork (formal papers for US application).

May 24, 2005 email from Nick Russell to Anton Felich asking if Anton Felich had a chance to follow up on paperwork (formal papers for US patent application).

May 24, 2005 email from Anton Felich to Nick Russell indicating that he had been advised to NOT SIGN.

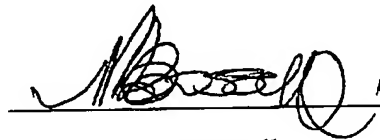
27. It is my opinion that together, these emails indicate that Mr. Felich was presented with the formal papers for filing the US counterpart application and that Mr. Felich, based on professional advice, refused to sign those papers. There is no issue as to whether or not papers were presented for signature. It is clear that there was a conscious decision on the part of Mr. Felich to NOT SIGN the US application.



N. RUSSELL

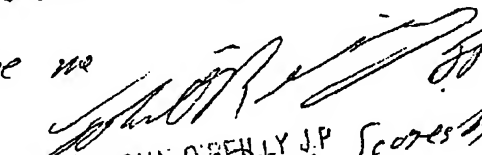
28. I believe that it is unlikely that I am going to get any further a response from Anton Felich. He has previously indicated his unwillingness to participate any further due to legal advice (correct or incorrect) that he has received concerning the potential for him to be exposed to liability in the future.


29. I declare, under penalty of the perjury laws of the United States, that all statements made herein of my own knowledge are true and that all statements made based on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.


Nicholas Russell

5.7.06
Date

*Signed by the above Nicholas Russell
be fore me*


JOHN O'REILLY J.P. *Scoresby*
92 Stamford Drive
A Justice of the Peace for the State of Victoria
(Reg. No. 7523) *Australia*


N. Russell

Attorney Docket No.: 034164.002
U.S. Appln. No. 10/522,809



Is the document marked "11"
to in the statutory declaration/
of *Nick Russell*
sworn this *5th* day of
July 2006, before me.
John O'Reilly
John O'Reilly, J.P., a Justice of the
Peace for the State of Victoria.

Appendix A

From: Anton Felich [anton.felich@clearweb.com.au]
Sent: Tuesday, May 24, 2005 4:13 PM
To: Nick Russell
Subject: RE: Patent stuff
Hey ya Nick,

Yeah spoke to him yesterday and he advised me not to sign it, something about liability or responsibility if it goes to market or something, I didn't really understand what he meant.

Is there anything else I can do to help ya out?

Cheers,

Anton

From: Nick Russell [mailto:nick@inchain.com.au]
Sent: Tuesday, 24 May 2005 12:01 PM
To: anton.felich@clearweb.com.au
Subject: FW: Patent stuff

Hi Anton,

Have you had a chance to follow up with the lawyer re that paperwork? Our patent lawyer is chasing me on it.

Nick

From: Anton Felich [mailto:anton.felich@clearweb.com.au]
Sent: Thu 14/04/2005 12:03 PM
To: Nick Russell
Subject: RE: Patent stuff
Hey Nick,

Sorry about the delay, didn't understand some of the stuff in the document so I gave it to one of the lawyers to interpret for me, will follow it up with him today for ya.

Cheers,

Anton

N. Russell
N. Russell

From: Nick Russell [mailto:nick@inchain.com.au]
Sent: Wednesday, 6 April 2005 10:57 PM
To: anton.felich@clearweb.com.au
Subject: FW: Patent stuff

Hi Anton,

Have you had a chance to sign the patent paperwork as yet?

Nick

From: Nick Russell
Sent: Wed 9/03/2005 2:58 PM
To: anton.felich@clearweb.com.au
Subject: Paperwork
Hi Anton,

How goes it, what are you up to on your side of the world? I've got some of the paperwork on the patent that I need to get you to sign. Are you still at the same address or have you moved? Can you send me over the details and I will forward the paperwork. Let me know and fill me in on how it's going

Cya

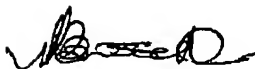
Nick

Inchain Pty Ltd
1270 Ferntree Gully Road,
Scoresby, VIC 3179
Australia

Tel: +61 3 9730 3991
Fax: +61 3 9730 3992
Email: nick@inchain.com.au

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From: Anton Felich [anton.felich@clearweb.com.au]
Sent: Tuesday, March 15, 2005 5:45 PM
To: Nick Russell
Subject: RE: Paperwork


N. Russell

Hey Nick,

All good here, I'm all over the place at the moment so might get you to send it to mum and
dads and I'll take care of it next time I see them.

6 Grange Road
Kalorama
VIC 3766

Cheers,

Anton

From: Nick Russell [mailto:nick@inchain.com.au]
Sent: Wednesday, 9 March 2005 2:58 PM
To: anton.felich@clearweb.com.au
Subject: Paperwork

Hi Anton,

How goes it, what are you up to on your side of the world? I've got some of the paperwork
on the patent that I need to get you to sign. Are you still at the same address or have you
moved? Can you send me over the details and I will forward the paperwork. Let me know
and fill me in on how it's going


Cya

Nick

Inchain Pty Ltd
1270 Ferntree Gully Road,
Scoresby, VIC 3179
Australia

Tel: +61 3 9730 3991
Fax: +61 3 9730 3992
Email: nick@inchain.com.au

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N. Russell

Attorney Docket No.: 034164.002
U.S. Appl. No. 10/522,809

From: Nick Russell
Sent: Tue 6/27/2006 4:32 PM
To: anton.felich@spectral.com.au
Cc: Anton Felich
Subject: US patent application

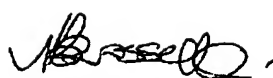
Hi Anton,

Hope all is well. I heard a rumour that you may be off on holidays but not sure. I submitted the patent in the USA with your email re not signing the document, but apparently I need more info. The US Patent office said it was not acceptable because I didn't provide you with the original application together with the declaration, the bulk of which was written by us anyway, go figure.

Is it possible for you to send me an email that says something similar to "I confirm that I have seen the declaration, which I refuse to sign, and US specification including the claims and drawings [attached]."

Thanks Anton, hear from you soon.

Nick


N. Russell.

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